

REMARKS

Applicants thank the Examiner for withdrawing the enablement rejection of claims 30 and 31 in light of Applicant's response filed on April 23, 2003. Claims 16 and 18-43 have been rejected. Applicants cancel claims 23-24 and 32-43 without prejudice and reserve the right to pursue these claims or claims of same or similar scope in this or a related application. Accordingly, with the entry of this amendment, claims 16, 18-22, and 25-31 are now pending in this application. No new matter is added by this amendment. Applicants respectfully submit that claims 16, 18-22 and 25-31 are in condition for allowance.

Formal Matters

The Examiner has not considered some of the references that were cited on an Information Disclosure Statement filed on February 26, 2003. The Examiner, however, has indicated that the Examiner will consider these references if a clearer copy is provided. Accordingly, Applicants submit with this paper, a clearer copy of all the references that were not previously considered. Applicants respectfully request that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached copy of Form PTO-1449 filed February 26, 2003. Additionally, Applicants submit a copy of the same Form PTO-1449 considered by the Examiner on July 7, 2003, for Examiner's convenience.

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Nonstatutory Double Patenting Rejection

Claims 16 and 18-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting rejection as being unpatentable over claims 16-20 of co-pending U.S. Patent Application No. 09/512,930, now allowed.

The Examiner has objected to the terminal disclaimer filed by the Applicants on April 23, 2003, to overcome this rejection. Specifically, the Examiner contends that the person who signed the terminal disclaimer is not authorized to act on behalf of the assignee of the instant application. Applicants disagree and respectfully submit that the person who signed the terminal disclaimer is authorized to sign on the behalf of the assignee.

Applicants thank the Examiner for the telephone discussion of August 5, 2003, in which the Examiner provided the Applicants with the name of the appropriate person to contact regarding rejection of the terminal disclaimer filed in this application. Pursuant to a subsequent discussion with Mr. Bill Dickson at the U.S. Patent Office, Applicants now believe that the Examiner will withdraw this rejection. Accordingly, Applicants request that this rejection be withdrawn and request entry as such.

Written Description Rejection

The Examiner has rejected claims 23, 24, 33-37 and 39-43 under 35 U.S.C. § 112, first paragraph, as allegedly lacking written description support in the specification. In particular, the Examiner is contending that the specification does not set forth the epitope on the 40 kD or 35 kD subunits of IL-12, as recited in claims 23 and 24, or

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blocking formation of heterodimer using an antagonist of IL-12 such as an antibody, as recited in independent claims 33 and 39.

Without acquiescing to this rejection, however, in order to further prosecution, Applicants cancel claims 23 and 24, 33-37 and 39-43 without prejudice, thereby rendering this rejection moot. Accordingly, Applicants request that this rejection be withdrawn and that pending claims 16, 18-22, and 25-31 are in condition for allowance.

Enablement Rejection

The Examiner has rejected claims 23, 24 and 32-43 under 35 U.S.C. § 112, first paragraph, as allegedly not enabled by the specification. The Examiner acknowledges that the specification is enabling for using an IL-12 antibody in a method to treat rheumatoid arthritis. However, the Examiner alleges that the specification fails to enable use of an antibody that only binds to either the 40 kD subunit or the 35 kD subunit of IL-12 or an antibody that binds to an epitope on a 40 kD or a 35 kD subunit of IL-12 in the treatment of rheumatoid arthritis.

Without acquiescing to this rejection, however, in order to further prosecution, Applicants cancel claims 23, 24 and 32-43 without prejudice, thereby rendering this rejection moot. Accordingly, Applicants request that this rejection be withdrawn.

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CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing all the pending claims in condition for allowance. Applicants submit that this amendment does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

In view of the foregoing, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of all the claims. Should the Examiner not believe that the claims are in condition for allowance, Applicants request that she please contact their undersigned representative at (202) 408-4086 for an interview to discuss the application.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: September 25, 2003

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